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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/043,888

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EXAMINER

DURAN, ARTHUR D

ART UNIT

PAPER NUMBER

3622

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/043,888	<b>Applicant(s)</b> STEINMAN ET AL.	
	<b>Examiner</b> Arthur Duran	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10, 13, 20, 22, 23, 56 and 57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10, 13, 20, 22, 23, 56, 57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 10, 13, 20, 22, 23, 56, 57 have been examined.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/31/09 has been entered.

#### ***Response to Amendment***

The Amendment filed on 8/31/09 is sufficient to overcome the prior rejection. However, a new 102 and 103 rejection has been made.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10, and its dependent claims, is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method claim that fails to meet one of the above requirements is not in

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compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. To correct this issue, the independent claim could be amended such that at least one significant feature (not just data gathering or outputting) of the body of the claims actively uses a technological apparatus (computer, server, processor, etc).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10, 13, 22, 23, 56, 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Dustin (6,496,857).

Claims 10, 22, 23. Dustin discloses:

serving a first Web page to each of a plurality of users, the first Web page including a small form of an the advertisement (Figs. 2-2, 3-2, 4-2, 4-3; Abstract); and serving a second Web page to each of the plurality of users, the second Web page including a large form of the advertisement wherein the large form of the advertisement (i) has dimensions larger than the small form and (ii) has similar shape and proportions as the small form (Figs. 2-3, 4-2, 4-3; Abstract; 7:59-8:5).

Claim 13. (Dustin further discloses the method of claim 10, further comprising:

providing an indication of an opportunity to view said large form of said advertisement to each user (7:1-20; 7:59-8:5); and

receiving an indication of willingness to view said large form of said advertisement from each user (7:1-20; 7:59-8:5).

Claim 56. Dustin further discloses wherein one or more a brand component, said small form of said advertisement, and said large form of said advertisement is served for a fixed period of time (7:1-20).

Claim 57. Dustin further discloses:

receiving an indication of a confirmation of a viewing of at least one of a brand component, said small form of said advertisement, and said large form of said advertisement (1:65-2:16; 7:1-20; 7:59-8:5); and

receiving an indication of a willingness to view at least one of said brand component, said small form of said advertisement, and said large form of said advertisement (7:1-20; 7:59-8:5; 1:65-2:16).

Note that the user selecting the thumbnail version of the ads acts as the user confirming viewing of the thumbnail/small form of the ad. Also, the selecting the thumbnail/small version of the ad in order to see the large/full form of the ads acts as a user indicating a willingness to see the large/full form of the ad.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20, 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dustin (6,496,857).

Claim 20. Dustin discloses the above. Dustin does not explicitly disclose wherein said large form of said advertisement is scrolled on the second Web page. However, Dustin discloses scrolling to view ads (7:1-20) and that large size forms of ads can be presented (Fig. 2-3 and above citations). And, the MPEP 2144.04.IV.A states that changes in size are obvious. Hence, it is obvious that the large size of Dustin's ads can be increased even larger to warrant the scrolling capability of Dustin for viewing. One would be motivated to do this to present ads in a desired large size and with the necessary functionality for viewing.

Claim 56. Dustin discloses the above. Dustin does not explicitly disclose wherein one or more a brand component, said small form of said advertisement, and said large form of said advertisement is served for a fixed period of time. However, Dustin discloses displaying ads for a period of time (7:1-20) and the Applicant states that it was obvious, old and well known to display ads for a fixed period of time on a screen (Applicant's own Specification PG\_Pub version at [7]). Hence, it is obvious that Dustin can display the ads for a fixed period of time. One would be motivated to do this to better display ads for a relevant period.

***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection above. Please see the Dustin reference above.

***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Zustak 20020087402 at [50, 64]; Mannik 20040122731 and Geilfuss 20020075332 disclose small versions of ads and large versions of ads. Mannik further discloses IER or interactive electronic representations of ads.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arthur Duran  
Primary Examiner  
Art Unit 3622

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Primary Examiner, Art Unit 3622  
9/15/2009